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Paper No. 8

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JUN 20 2002

OFFICE OF PETITIONS

In re Application of
Daniel J. Sullivan,
Mark P. Crockett, John Epler and
Robert A. Hilgart
Application No. 09/928,130
Filed: August 10, 2001
Title: COMPUTERIZED RISK MANAGEMENT
MODULE FOR MEDICAL DIAGNOSIS

DECISION REFUSING STATUS
UNDER 37 C.F.R. §1.47(a)

This is a decision on the "Petition under 37 CFR §1.47(a)," filed March 15, 2002.

The petition under 37 CFR §1.47(a) is **DISMISSED**.

Rule 47 applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 C.F.R. §1.136(a).

The above-identified application was filed on August 10, 2001, without an executed declaration, and naming Daniel J. Sullivan, Mark D. Crockett, John Epler and Robert A. Hilgart as joint inventors. In response to a "Notice to File Missing Parts of Nonprovisional Application," mailed September 18, 2001, applicant timely filed the instant petition under §1.47(a) (and fee) and late surcharge under §1.16(e). Accompanying the petition was a declaration executed by inventors Crockett, Epler and Hilgart; and a declaration executed by inventor Epler on behalf of non-signing inventor Sullivan. Rule 47 applicants assert that status under §1.47(a) is proper because inventor Sullivan refuses to execute the declaration. In support thereof, applicants submit a declaration of facts of patent attorney George Wheeler.

A grantable petition under 37 C.F.R. §1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or found, after diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor.

The petition includes payment of the petition fee and a statement of the last known address of non-signing inventor Sullivan. By statement of attorney Wheeler with supporting documentary evidence, rule 47 applicants have provided evidence that non-signing inventor

Sullivan has refused to join in the application after having been presented with the application papers. However, the petition is not grantable because the declaration submitted does not satisfy requirement (2).

As to requirement (2), the declaration as submitted is not acceptable. 37 CFR 1.47(a) and 35 U.S.C. 116, second paragraph, require all available joint inventors to file an application "on behalf of" themselves and on behalf of a joint inventor who "cannot be found or reached after diligent effort" or who refuses to "join in an application." Thus, in addition to other requirements of law (35 U.S.C. 111(a) and 115), in an application deposited in the U.S. Patent and Trademark Office pursuant to 37 CFR 1.47(a):

(A) All the available joint inventors must (1) make oath or declaration on their own behalf as required by 37 CFR 1.63 or 1.175 (see MPEP §602, §605.01, and §1414) and (2) make oath or declaration on behalf of the non-signing joint inventor as required by 37 CFR 1.64. An oath or declaration signed by all the available joint inventors with the signature block of the non-signing inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the non-signing inventor(s), unless otherwise indicated.

(Emphasis added).

Here, applicants have indicated, by having inventor Epler sign on behalf of non-signing inventor Sullivan, that the declaration as submitted is not signed by all the available joint inventors on behalf of themselves and on behalf of joint inventor Sullivan. A declaration properly executed by all available joint inventors on behalf of non-signing inventor Sullivan is required.

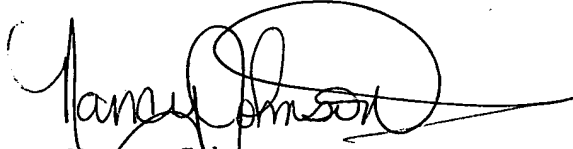
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